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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,410	12/18/2000	Tommy Dolan	34647-00430USPT	3692

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JENKENS & GILCHRIST
3200 Fountain Place
1445 Ross Avenue
Dallas, TX 75202-2799

EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/740,410

Applicant(s)

DOLAN, TOMMY

Examiner

Lisa Hashem

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-19 are pending in this office action.

Information Disclosure Statement

2. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 4, is attached to the instant office action.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on December 18, 2000 have been objected. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-15, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,995,848 by Nguyen in view of U.S. Patent No. 6,154,644 by Murray.

Regarding claim 1, Nguyen discloses a method for completing a call from a calling party to a mobile station (MS) of a called party that was not previously completed because of a busy signal by the called party MS (see Abstract), comprising: determining that the MS of the called party has moved (column 8, lines 6-9); and thereafter, inherently initiating a callback between the calling party and the called party in response to the determining step (column 8, lines 23-27).

Nguyen does not disclose a method for completing a call from a calling party to a MS of a called party that was not previously completed because of no response by the called party MS.

Murray discloses a method for completing a call from a calling party to a MS of a called party that was not previously completed because of no response by the called party MS (see Abstract), said method includes initiating a callback between the calling party and the called party (column 3, lines 59-63).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Nguyen to complete a call from a calling party to a MS of a called party that was not previously completed because of no response by the called party MS as taught by Murray to include a system that supports different statuses of a called party MS. One of ordinary skill in the art would have been lead to make such a modification since the status of the called MS can be determined as: available, inactive, or busy, depending on the situation the called party is in and call handling options are based upon the status of the called party MS.

Regarding claim 2, the method according to claim 1 mentioned above, wherein Nguyen further discloses said determining step comprises detecting that the MS of the called party has changed its location, inherently by the called party roaming in another service area (column 8, lines 6-9).

Regarding claim 4, the method according to claim 1 mentioned above, wherein Nguyen further discloses, before the step of initiating a callback, deciding whether a callback should be initiated when it has been determined that the MS of the called party has moved (column 8, lines 23-27 and lines 59-65; column 9, lines 1-25).

Regarding claim 5, the method according to claim 4 mentioned above, wherein Nguyen further discloses a decision of said deciding step is based on one input determining that the MS of the called party has moved (column 8, lines 6-9) and at least one further input indicative that the callback may be successful, upon detecting that the MS is busy (column 8, line 59).

Regarding claim 6, the method according to claim 5 mentioned above, wherein Nguyen further discloses said step of determining that the MS of the called party has moved comprises making a first determination that the MS of the called party has moved, wherein the MS has roamed outside the home service area (column 8, lines 6-9), and wherein said at least one further input comprises making a second determination that the MS of the called party has moved, wherein a query process is used (column 8, lines 61-65).

Regarding claim 7, the method according to claim 6 mentioned above, wherein Nguyen further discloses said first and second determinations are made by first and second movement determination procedures, respectively; wherein the MS has moved out of its home service area and then the query process is used with a time period and frequency (column 8, lines 6-9, lines 42-45, and lines 61-65).

Regarding claim 8, the method according to claim 5, wherein Nguyen further discloses said at least one further input comprises the expiration of a period of time before said callback is initiated (column 8, lines 59-65).

Regarding claim 9, the method according to claim 1, wherein Nguyen further discloses the MS of the called party (Figure 5, 145) answers a callback attempt prior to contacting the calling party (Figure 5, 151; column 9, lines 5-25).

Regarding claim 10, the method according to claim 1 mentioned above, wherein Nguyen further discloses said method is provided in a call completion service, and wherein said service is available to the calling party (column 8, lines 23-38).

Regarding claim 11, the method according to claim 1 mentioned above, wherein Nguyen further discloses receiving a call completion request from the calling party (column 8, lines 23-27) before the determining step.

Regarding claim 12, the method according to claim 10 mentioned above, wherein Nguyen further discloses, when said service is subscribed to by said calling party, the method further includes the step of inquiring if the calling party wants a callback initiated before the callback is initiated (column 8, lines 23-27).

Regarding claim 13, the method according to claim 1 mentioned above, wherein Nguyen further discloses including the step of canceling the callback if the determining step does not determine that movement has occurred within a set period of time (column 8, lines 59-67).

Regarding claim 14, the method according to claim 1 mentioned above, wherein Nguyen further discloses said determining step includes inherently monitoring the called MS on a periodic basis to determine if it has moved (column 8, lines 6-9 and lines 59-65).

Regarding claim 15, Nguyen discloses an apparatus for implementing a callback on a busy feature when a call from a calling party to a mobile station (MS) of a called party is not completed due to a busy signal (see Abstract and Figure 5), said apparatus comprising: a movement determination unit or visitor mobile switching center (V-MSC) for determining that the MS of the called party has moved (column 8, lines 6-9) and a callback initiating unit or

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gateway mobile switching center (G-MSC) for initiating a callback between the calling party and the called party (column 8, lines 23-38).

Nguyen does not disclose an apparatus for implementing a callback on a no response feature when a call from a calling party to a MS of a called party is not completed due to no response from the called party.

Murray discloses a callback system for implementing a callback on a no response feature when a call from a calling party to a MS of a called party is not completed due to no response from the called party (see Abstract), said system includes a service control point or SCP for initiating a callback between the calling party and the called party (column 3, lines 59-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Nguyen to complete a call from a calling party to a MS of a called party that was not previously completed because of no response by the called party MS as taught by Murray to include a system that supports different statuses of a called party MS. One of ordinary skill in the art would have been lead to make such a modification since the status of the called MS can be determined as: available, inactive, or busy, depending on the situation the called party is in and call handling options are based upon the status of the called party MS.

Regarding claim 18, please see the argument to the apparatus of claim 15 above to reject the service in claim 18.

Regarding claim 19, the callback service according to claim 18 mentioned above, wherein Nguyen further discloses said service is available to be subscribed to by the calling party (column 8, lines 23-27).

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6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,995,848 by Nguyen in view of U.S. Patent No. 6,154,644 by Murray as applied to claim 2 above, and further in view of U.S. Patent No. 6,070,078 by Camp, Jr. et al (hereinafter Camp).

Regarding claim 3, the method according to claim 2 mentioned above, wherein Nguyen differs from claimed invention because he fails to teach said detecting step comprises detecting that the MS of the called party has changed its location utilizing mobile positioning technology.

Camp discloses a Global Positioning System (GPS) receiver located at a base station of a cellular telephone network. The base station transmits auxiliary information to the GPS receiver, which is located within a cellular telephone operating within the service area of the base station. The cellular telephone GPS receiver uses the auxiliary information to determine the location of the cellular telephone and transmits location information to the cellular telephone network via the cellular telephone and base station (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Nguyen in view of Murray to include mobile positioning technology as taught by Camp to determine the location of the MS of the called party. One of ordinary skill in the art would have been lead to make such a modification since a mobile positioning technology such as GPS would reduce the time and functionality to locate the MS in a wireless telephone network.

7. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,995,848 by Nguyen in view of U.S. Patent No. 6,154,644 by Murray, as applied to claim 15 above, and further in view of U.S. Patent No. 6,070,078 by Camp, Jr. et al (hereinafter Camp).

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Regarding claims 16-17, the apparatus according to claim 15 mentioned above, wherein Nguyen does not disclose said movement determination unit comprises a detection unit for detecting that the MS of the called party has changed its location and said detection unit utilizes mobile positioning technology.

Camp discloses a Global Positioning System (GPS) receiver located at a base station of a cellular telephone network. The base station transmits auxiliary information to the GPS receiver or movement detection unit, which is located within a cellular telephone operating within the service area of the base station. The cellular telephone GPS receiver uses the auxiliary information to determine the location of the cellular telephone and transmits location information to the cellular telephone network via the cellular telephone and base station (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a movement determination unit or GPS receiver, as taught by Camp, for the apparatus of Nguyen in view of Murray, for determining that the MS of the called party has moved. One of ordinary skill in the art would have been lead to make such a modification since the V-MSC of Nguyen in view of Murray can utilize the GPS receiver of Camp to determine the location of the MS of the called party when it has roamed out of its home service area so that successful callback attempts can be made and the apparatus can utilize the technique of GPS to assist in mobile positioning.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent No. 5,784,438 by Martinez teaches a callback method in a wireline telephone system when the calling party receives no response from the called party

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for formal communications intended for entry)

Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

lh

November 13, 2003

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

